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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/750,842

01/05/2004

Hiroaki Okita

2003\_1923A

2492

513

7590

05/04/2006

WENDEROTH, LIND & PONACK, L.L.P.

2033 K STREET N. W.

SUITE 800

WASHINGTON, DC 20006-1021

EXAMINER

PICKETT, JOHN G

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/750,842	OKITA, HIROAKI	
	<b>Examiner</b>	<b>Art Unit</b>	
	Gregory Pickett	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2/17/05</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 6, and 14-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 6 and 15-17 recites the limitation "said back plate part" in lines 2/3. There is insufficient antecedent basis for this limitation in the claim.

Claim 14 appears to enable the holder member to be attached to one of the top or bottom case parts, whereas claim 2 (from which claim 14 depends) clearly attaches the holder member to the back plate part. This appears to be an improper broadening of the claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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2. Claims 1, 5, 7 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Nesbitt et al (US 5,662,216; hereinafter Nesbitt).

Claim 1: Nesbitt discloses a disk storage case **10** with a case body **12** divided into a pair of case parts **16 & 18** located in a top **18** and a bottom **16** sides of case body **12** and coupled to each other by hinge **20/22/24/26**, a holder member **14** protruding from bottom **16** and provided with a groove **40** formed along an inner peripheral edge of a circular arc, and a window section **30/32** to allow a disk to be inserted as claimed.

Claim 5: Nesbitt discloses elastic arc arms **36 & 38** with a narrowed opening side of holder **14** formed by end portions **44 & 46**.

Claims 7 and 21: Nesbitt discloses guide means **64 & 66**, which are the functional equivalents of the guide means disclosed by the applicant.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
3. Claims 3, 12, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nesbitt in view of Covington (US 4,817,079).

Claim 3: Nesbitt, as applied to claim 1 above, discloses the claimed invention except for the closing member.

Covington discloses closing members **50 & 52** for a disk case **10** adapted to be pushed inward to open with a biasing force provided by torsion springs **58**. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the window section of Nesbitt with closing members as taught by Covington in order to limit debris entry.

Claim 12: Nesbitt discloses elastic arc arms **36 & 38** with a narrowed opening side of holder **14** formed by end portions **44 & 46**.

Claim 19: Nesbitt discloses guide means **64 & 66**, which are the functional equivalents of the guide means disclosed by the applicant.

4. Claims 4, 13, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nesbitt, as applied to claim 1 above, and further in view of Lau (US 6,554,132 B2)..

Claim 4: Nesbitt discloses the claimed invention except for the plurality of holder members.

Lau discloses a disk case with a plurality of holding members **40** (see Figure 4). It would have been obvious to one of ordinary skill in the art at the time the invention

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was made to provide the case of Nesbitt with a plurality of holding members in order to retain a large number of disks within the same case. It has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Claim 13: Nesbitt discloses elastic arc arms **36 & 38** with a narrowed opening side of holder **14** formed by end portions **44 & 46**.

Claim 20: Nesbitt discloses guide means **64 & 66**, which are the functional equivalents of the guide means disclosed by the applicant.

5. Claims 6, 17, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nesbitt as applied to claims 1 and 5 above, and further in view of Uchida (US 2002/0046960 A1).

Claims 6 and 17: Insofar as the examiner can determine the scope of the claim, Nesbitt discloses the claimed invention except for the pivotal mounting of the holder member.

Uchida discloses a pivotal holder member **3**, arranged with restricted rotation, so as to accommodate removal of the disk when the case is open. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the case of Nesbitt with a pivoting holder as taught by Uchida in order to easily remove the disk from the holder when the case is open.

Claim 22: Nesbitt discloses guide means **64 & 66**, which are the functional equivalents of the guide means disclosed by the applicant.

6. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nesbitt-Covington as applied to claim 3 above, and further in view of Lau.

Nesbitt-Covington discloses the claimed invention except for the plurality of holder members.

Lau discloses a disk case with a plurality of holding members **40** (see Figure 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the case of Nesbitt-Covington with a plurality of holding members in order to retain a large number of disks within the same case. It has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

7. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nesbitt-Covington as applied to claim 3 above, and further in view of Uchida.

Nesbitt-Covington discloses the claimed invention except for the pivotal mounting of the holder member.

Uchida discloses a pivotal holder member **3**, arranged with restricted rotation, so as to accommodate removal of the disk when the case is open. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the case of Nesbitt-Covington with a pivoting holder as taught by Uchida in order to easily remove the disk from the holder when the case is open.

8. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nesbitt-Lau as applied to claim 4 above, and further in view of Uchida.

Nesbitt-Lau discloses the claimed invention except for the pivotal mounting of the holder member.

Uchida discloses a pivotal holder member **3**, arranged with restricted rotation, so as to accommodate removal of the disk when the case is open. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the case of Nesbitt-Lau with a pivoting holder as taught by Uchida in order to easily remove the disk from the holder when the case is open.

9. Claims 2, 9, 11, 14, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tempongko (US 2003/0052022 A1; provided by applicant) in view of Nesbitt.

Claim 2: Tempongko discloses a disk storage case **30** with a case body divided into three parts including a back plate part **34** and a pair of case parts **32a & 32b** located in a top **32b** and a bottom **32a** sides of case body **30** and coupled to each other by hinge **36a & 36b**, and a holder member **40** protruding from back plate part **34** and provided with a groove **52** formed along an inner peripheral edge of a circular arc. Tempongko merely lacks the window section.

Nesbitt discloses a window section **30/32** to allow a disk to be inserted as claimed. It would have been obvious to one of ordinary skill in the art at the time the



invention was made to provide the case of Tempongko with a window section as taught by Nesbitt in order to enable the insertion of a disk while the case is closed.

Claim 9: Tempongko anticipates a plurality of holder members (see Figures 6 and 7).

Claim 11: Tempongko discloses a holder member **40** made of a circular arc arm of elastic material and arranged and functioning as claimed.

Claim 14: In Figure 7, Tempongko discloses multiple holder members **72a, 72b, & 72c** that are flexible to fan out when open and collapse when closed. This holder member arrangement is considered pivotally mounted with restricted rotation.

Claim 18: Nesbitt teaches a guide means **64 & 66** to guide the disk into the holder member. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the case of Tempongko-Nesbitt with a guide means as taught by Nesbitt in order to guide the disk into the holder member.

10. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tempongko-Nesbitt as applied to claim 2 above, and further in view of Covington.

Tempongko-Nesbitt, as applied to claim 2, discloses the claimed invention except for the closing member.

Covington discloses closing members **50 & 52** for a disk case **10** adapted to be pushed inward to open with a biasing force provided by torsion springs **58**. It would have been obvious to one of ordinary skill in the art at the time the invention was made

to provide the window section of Tempongko-Nesbitt with closing members as taught by Covington in order to limit debris entry.


### ***Conclusion***


11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Greg Pickett  
Examiner  
28 April 2006

  
Mickey Yu  
Supervisory Patent Examiner  
Group 3700